

REMARKS

Claims 1, 52, 53 and 55 have been amended to require the presence of a volatile oil in an amount insufficient to cause at least one condition selected from the group consisting of a matte appearance, the sensation of dryness, the sensation of tautness and the sensation of discomfort on the keratin material after application of said composition to the keratin material. Support for these amendments exists, *inter alia*, in the examples of the present application as well as page 4, lines 1-13. These claims have also been amended to require the presence of from about 0.1% to about 30% by weight of the total weight of the composition of an inert particulate phase. Support for these amendments exists, *inter alia*, in original claim 43. Claim 43 has been canceled.

Claim 35 has been amended in a non-limiting manner by replacing the phrase "cosmetic active agents and dermatological active agents" with the more generic phrase --active agents--.

Claim 47 has been amended in a non-limiting manner by changing the dependency of this claim from claim 1 to claim 62 and by replacing the term "solvent" with the term "oil."

Claim 54 has been amended in a non-limiting manner to correct a typographical error.

Claim 56 has been amended in a non-limiting manner to require that the composition be free of volatile silicone oil rather than all volatile solvent.

New Claims 58-61 require the presence of a dyestuff in addition to the claimed inert particulate phase. Support for these new claims exists, *inter alia*, at page 21, line 5 *et seq.*

New Claim 62 requires the presence of 0.1-30% by weight of the total weight of the composition of an inert particulate phase and from 0 to about 5% by weight of the total weight of the composition of a volatile oil. Support for these new claims exists, *inter alia*, at page 19, line 22 *et seq.* and page 20, line 20 *et seq.*

New Claims 63-95 generally correspond to original claims 2-52 except that they depend from claim 62 rather than claim 1. Accordingly, support for these new claims exists, *inter alia*, in the original claims.

New Claims 96 and 97 require less than about 5% by weight with respect to the total weight of the composition of volatile oil to be present. Support for this new claim exists, *inter alia*, at page 19, line 22 *et seq.*

Claims 1-42 and 44-97 are currently pending, although claims 53-57 have been withdrawn from consideration. Upon indication of allowable subject matter, Applicant intends to seek rejoinder of the withdrawn claims.

As noted in the present specification, transfer-resistant compositions are typically uncomfortable to wear due to unfavorable sensations such as, for example, sensations of dryness, tautness and discomfort. (See, for example, page 4, lines 1-2). Moreover, transfer-resistant compositions typically have a matte appearance after application. (See, for example, page 4, lines 3-4). These drawbacks discourage customers from using transfer-resistant compositions. (See, for example, page 4, line 3).

The present invention addresses these problems associated with transfer-resistant compositions. Specifically, the claimed invention provides a composition containing a specific mixture of a non-volatile hydrocarbon-based oil, a non-volatile silicone, and from about 0.1 to about 30% by weight of an inert particulate phase.

Significantly, the claimed invention contains little or no volatile oil such that the oil, if present, does not cause a matte appearance or the sensation of dryness, tautness and/or discomfort upon application. To the contrary, the present invention provides a transfer-resistant composition which has a glossy appearance and is comfortable to wear. As such, it represents an advance in the art deserving of patent protection.

The Office Action rejected claims 1-3, 5-10, 11, 18, 29-31, 35-40, 42, 43, 46, 48, and 50-52 under 35 U.S.C. §102 as anticipated by U.S. patent 5,690,9186 ("Jacks"), and claims 1-10, 24-30, 32, 33, 35, 27-43 and 45-52 as anticipated by U.S. patent 5,738,841 ("Mellul"). The Office Action also rejected claims 11-23, 34 and 44 under 35 U.S.C. §103 as obvious over Mellul, alone or in combination with JP 63119412 ("JP 412"). In view of the following comments, Applicant respectfully requests reconsideration and withdrawal of these rejections.

Regarding the rejection based on Jacks, this reference discloses transfer-resistant compositions containing an amount of volatile oil beyond that presently claimed. Jacks' example 2, upon which the rejection is based, discloses a lipstick containing 34.5% cyclomethicone and 10% isododecane. As demonstrated in comparative example 7 of the present application (pages 36-38), lipsticks containing this much volatile oil suffer from the appearance and sensation problems discussed above. Thus, Jacks does not disclose transfer-resistant compositions which contain a volatile oil in an amount insufficient to cause a matte appearance or the sensation of dryness, tautness and/or discomfort upon application and which also contain the claimed silicone compound, the claimed hydrocarbon-based oil and the claimed inert particulate phase. That Jacks fails to disclose the claimed compositions including the critical element of having little or no volatile oil present is highlighted by the fact that

Jacks adds a blend of moisturizing and moisture retaining agents to his transfer-resistant compositions containing “conventional” ingredients. (Col. 1, lines 45-48). Presumably, if Jacks’ compositions did not cause the sensation problems discussed above such as the sensation of dryness, no need would exist for Jacks to add moisturizers and moisturizing agents to his compositions.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the § 102 rejection based on Jacks.

Regarding the § 102 rejection based on Mellul, Mellul does not disclose compositions containing from about 0.1 to about 30% inert particulate phase. Applicant respectfully submits that for this reason alone the rejection under § 102 is improper and should be withdrawn.

Moreover, Mellul does not render the present invention obvious. Nowhere does Mellul teach one skilled in the art to use from about 0.1 to about 30% inert particulate phase or a non-volatile silicone compound. Rather, Mellul discloses compositions containing 0% inert particulate phase or 48% or more inert particulate phase. Similarly, Mellul teaches that volatile silicone oils are interchangeable with non-volatile silicone compounds. (See, col. 2, line 51). One skilled in the art, seeking to produce a composition addressing the appearance and sensation problems associated with transfer-resistant compositions, would not be motivated by Mellul to selectively produce a composition having from about 0.1 to about 30% inert particulate phase and a non-volatile silicone compound with the expectation that such a composition would not result in a matte appearance or the sensation of dryness, tautness and/or discomfort. Moreover, based on Mellul’s disclosure concerning the interchangeability of volatile and non-volatile silicone compounds, one skilled in the

art would not have been motivated to limit the amount of volatile oils such that little or no volatile oil were present.

Regarding the § 103 rejection based on Mellul in combination with JP 412, JP 412 relates to 12-hydroxystearic acid, not polyhydroxystearic acid. 12-hydroxystearic acid is a surfactant-cleansing agent, whereas polyhydroxystearic acid is a suspending agent-nonsurfactant. (See, Tab A). Because JP 412 relates to 12-hydroxystearic acid, not polyhydroxystearic acid, the rejection of claims 11-23 is improper and should be withdrawn. Similarly, new claims 70-76 which correspond to claims 11-23 are also free of the cited art.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 11-23, 34 and 44 under 35 U.S.C. § 103,

The Office Action also rejected claims 1-51 under 35 U.S.C. § 112, second paragraph, asserting that the phrases “care or make-up composition” in claim 1, “cosmetic actives” in claim 35 and “pasty” in claim 37 are vague and indefinite. Applicant respectfully submits that the above amendments to claims 1 and 35 have rendered moot the first two bases of rejection. Moreover, with respect to the word “pasty” in claim 37, Applicant respectfully submits that the meaning of this term is definite, particularly in view of the definition provided at page 23, lines 16-19 of the present specification.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the rejections under § 112.

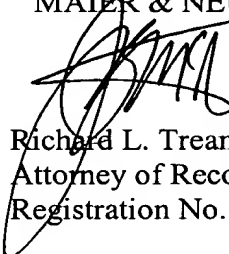
Finally, with respect to the double patenting rejections, Applicant respectfully submits that the above amendments have rendered these rejections moot. Moreover, regarding U.S. patent 6,326,012, claim 9 of this patent requires the presence of a

functionalized synthetic wax, a volatile hydrocarbon oil and a silicone gum, and serial no. 09/728,056 requires the presence of a volatile hydrocarbon-based solvent, a silicone compound dispersible in the volatile solvent and a non-volatile hydrocarbon oil which is incompatible with the silicone compound. Given that the pending claims do not require the presence of a functionalized synthetic wax, a volatile hydrocarbon oil or a silicone gum and that the pending claims require the non-volatile silicone and non-volatile hydrocarbon to be compatible, it is clear that the claims relied upon in the double patenting rejection are not directed to the claimed subject matter or obvious variants thereof. Accordingly, Applicant respectfully requests that the double patenting rejections be reconsidered and withdrawn.

Applicant believes that the present application is in condition for allowance.
Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Richard L. Treanor
Attorney of Record
Registration No. 36,379

Jeffrey B. McIntyre
Registration No. 36,867

Customer Number

22850

Tel #: (703) 413-3000
Fax #: (703) 413-2220

Definition: Polygonum Fagopyrum (Buckwheat) Leaf Extract is an extract of the leaves and shoots of the buckwheat, *Polygonum fagopyrum*. See "Regulatory and Ingredient Use Information," regarding the labeling names for botanical derived ingredients in Volume 1, Introduction, Part A.

Chemical Class: Biological Products

Function: Skin-Conditioning Agent - Miscellaneous

Technical/Other Names:

- Buckwheat Extract
- Buckwheat Leaf Extract
- Extract of Buckwheat
- Extract of Polygonum Fagopyrum
- Fagopyrum Sagittatum Extract
- Polygonum Fagopyrum (EU)
- **Trade Name Mixtures:**
 - Buckwheat Extract HS 2860 G (Grau)
 - Buckwheat Extract HS 2861 G (Grau)
 - Buckwheat Extract, Watersoluble (Croda GmbH)
 - Buckwheat HS (Alban Muller)
 - Buckwheat LS (Alban Muller)
 - Extrait De Sarrasin PPE PG40 (Yves Rocher)
 - Glycolysat of 7 Cereals (CEP (Solabia))

POLYGONUM MULTIFLORUM

Definition: See "Regulatory and Ingredient Use Information," regarding EU labeling names for botanical derived ingredients in Volume 1, Introduction, Part A.

Chemical Class: Biological Products

Technical/Other Names:

- Polygonum Multiflorum Extract (U.S.)
- Polygonum Multiflorum Root Extract (U.S.)

POLYGONUM MULTIFLORUM EXTRACT

Definition: Polygonum Multiflorum Extract is an extract of the herb, *Polygonum multiflorum*. See "Regulatory and Ingredient Use Information," regarding the labeling names for botanical derived ingredients in Volume 1, Introduction, Part A.

Chemical Class: Biological Products

Function: Not Reported

Technical/Other Names:

- Extract of Polygonum Multiflorum
- Polygonum Multiflorum (EU)

Trade Name Mixtures:

- Campo He Shou Wu Extract (Campo)

Polygonum Phytexcell (Croda GmbH)
VT-238 Extract of Fo-Ti (Vege-Tech)

POLYGONUM MULTIFLORUM ROOT EXTRACT

Definition: Polygonum Multiflorum Root Extract is an extract of the roots of the polygonum, *Polygonum multiflorum*. See "Regulatory and Ingredient Use Information," regarding the labeling names for botanical derived ingredients in Volume 1, Introduction, Part A.

Chemical Class: Biological Products

Function: Not Reported

Technical/Other Names:

- Extract of Polygonum
- Extract of Polygonum Multiflorum
- Polygonum Extract
- Polygonum Multiflorum (EU)
- Polygonum Multiflorum Extract

Trade Name Mixtures:

- Actiphyte of Polygoni Multiflora BG50 (Active Organics)
- Actiphyte of Polygoni Multiflora GL50 (Active Organics)
- Actiphyte of Polygoni Multiflora Lipo S (Active Organics)
- Actiphyte of Polygoni Multiflora PG50 (Active Organics)
- Chine Extract Polygonum Multiflorum (Ennagram)
- Fo-Ti 5:1 PG (Lipo)

POLYGONUM PERSICARIA

Definition: See "Regulatory and Ingredient Use Information," regarding EU labeling names for botanical derived ingredients in Volume 1, Introduction, Part A.

Chemical Class: Biological Products

Technical/Other Name:

- Polygonum Persicaria Extract (U.S.)

POLYGONUM PERSICARIA EXTRACT

Definition: Polygonum Persicaria Extract is an extract of the plant, *Polygonum persicaria*. See "Regulatory and Ingredient Use Information," regarding the labeling names for botanical derived ingredients in Volume 1, Introduction, Part A.

Chemical Class: Biological Products

Function: Skin-Conditioning Agent - Miscellaneous

Technical/Other Names:

- Extract of Polygonum Persicaria
- Polygonum Persicaria (EU)

Trade Name Mixture:

- Persicary HS (Alban Muller)

POLYHYDROXYSTEARIC ACID

CAS Nos.: 27924-99-8; 58128-22-6

Definition: Polyhydroxystearic Acid is a polymer of Hydroxystearic Acid (q.v.)

Information Sources: TSCA

Chemical Class: Synthetic Polymers

Function: Suspending Agent - Nonsurfactant

Technical/Other Name:

- Polyhydroxyoctadecanoic Acid

Trade Names:

- Arlacel P100 (Uniqema Americas)
- Solsperse 21000 (Zeneca)
- Veil 123 (Uniqema Solaveil)

Trade Name Mixtures:

- Spectraveil FIN (Uniqema Solaveil)
- Spectraveil IPM (Uniqema Solaveil)
- Spectraveil MOTG (Uniqema Solaveil)
- Spectraveil 70/MOTG (Uniqema Solaveil)
- Spectraveil 90/MOTG (Uniqema Solaveil)
- Spectraveil OP (Uniqema Solaveil)
- Spectraveil 70/OP (Uniqema Solaveil)
- Spectraveil TG (Uniqema Solaveil)
- Spectraveil TGOP (Uniqema Solaveil)
- Tioveil EUT (Uniqema Solaveil)
- Tioveil 50 EUT (Uniqema Solaveil)
- Tioveil FCM (Uniqema Solaveil)
- Tioveil 50 FCM (Uniqema Solaveil)
- Tioveil FIN (Uniqema Solaveil)
- Tioveil 50 FIN (Uniqema Solaveil)
- Tioveil FLO (Uniqema Solaveil)
- Tioveil FPT (Uniqema Solaveil)
- Tioveil 50 FPT (Uniqema Solaveil)
- Tioveil GCM (Uniqema Solaveil)
- Tioveil 50 GCM (Uniqema Solaveil)
- Tioveil GPT (Uniqema Solaveil)
- Tioveil IPM (Uniqema Solaveil)
- Tioveil 50 IPM (Uniqema Solaveil)
- Tioveil MOTG (Uniqema Solaveil)
- Tioveil 50 MOTG (Uniqema Solaveil)
- Tioveil OP (Uniqema Solaveil)
- Tioveil 50 OP (Uniqema Solaveil)
- Tioveil TG (Uniqema Solaveil)
- Tioveil 50 TG (Uniqema Solaveil)
- Tioveil TGOP (Uniqema Solaveil)
- Tioveil 50 TGOP (Uniqema Solaveil)

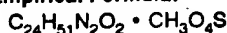
POLYISOBUTENE

CAS No.: 9003-27-4

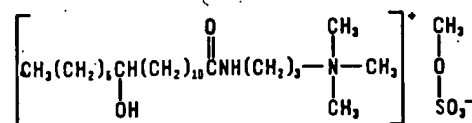
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HYDROXYSTEARAMIDOPROPYL TRIMONIUM METHOSULFATE

CAS No.: 127312-00-9

Empirical Formula:

Definition: Hydroxystearamidopropyl Trimonium Methosulfate is the quaternary ammonium salt that conforms to the formula:



Chemical Class: Quaternary Ammonium Compounds

Functions: Antistatic Agent; Hair Conditioning Agent

Technical/Other Names:

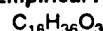
- 3-[(12-Hydroxy-1-Oxooctadecyl)Amino]-N,N,N-Trimethyl-1-Propanaminium Methyl Sulfate (Salt)
- 1-Propanaminium, 3-[(12-Hydroxy-1-Oxooctadecyl)Amino]-N,N,N-Trimethyl, Methyl Sulfate (Salt)

HYDROXYSTEARIC ACID

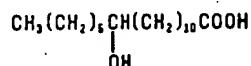
CAS Nos. EINECS Nos.

106-14-9 203-366-1

1330-70-7 215-545-1

Empirical Formula:

Definition: Hydroxystearic Acid is the fatty acid that conforms generally to the formula:



Information Sources: 21CFR175.105, 21CFR176.210, 21CFR178.3570, CIR: [S], JCIC, JCLS, JSQI, TSCA

Chemical Class: Fatty Acids

Function: Surfactant - Cleansing Agent

Surfactant-Cleansing Agent is included as a function for the soap form of Hydroxystearic Acid.

Technical/Other Names:

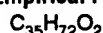
- 12-Hydroxyoctadecanoic Acid
- 12-Hydroxystearic Acid
- Octadecanoic Acid, 12-Hydroxy-

Trade Names:

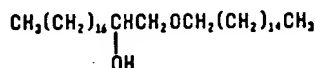
- Creasperse OB (C.I.T.)
- Creasperse WB (C.I.T.)
- HSA (CasChem)

Trade Name Mixture:

Macamat Wax (Wackherr)

HYDROXYSTEARYL CETYL ETHER**Empirical Formula:**

Definition: Hydroxystearyl Cetyl Ether is the organic compound that conforms to the formula:

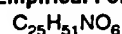


Chemical Classes: Alcohols; Ethers

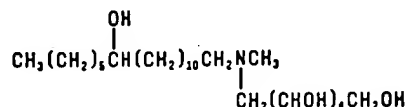
Function: Opacifying Agent

Trade Name Mixture:

Mexanyl GY (Chimex)

HYDROXYSTEARYL METHYL-GLUCAMINE**Empirical Formula:**

Definition: Hydroxystearyl Methylglucamine is the substituted aminosugar that conforms generally to the formula:



Chemical Classes: Amines; Polyols

Function: Antistatic Agent

HYMENAEA COUBBARIL

Definition: See "Regulatory and Ingredient Use Information," regarding EU labeling names for botanical derived ingredients in Volume 1, Introduction, Part A.

Chemical Class: Biological Products

Technical/Other Name:

Hymenaea Coubaril Bark Extract (U.S.)

HYMENAEA COUBBARIL BARK EXTRACT

Definition: Hymenaea Coubaril Bark Extract is an extract of the pods and bark of *Hymenaea coubaril*. See "Regulatory and Ingredient Use Information," regarding the labeling names for botanical derived ingredients in Volume 1, Introduction, Part A.

Chemical Class: Biological Products

Function: Not Reported

Technical/Other Names:

Extract of Hymenaea Coubaril
Hymenaea Coubaril (EU)

Trade Name Mixture:

Campo Jatoba (Campo)

HYPERICUM PERFORATUM

Definition: See "Regulatory and Ingredient Use Information," regarding EU labeling names for botanical derived ingredients in Volume 1, Introduction, Part A.

Chemical Class: Biological Products

Technical/Other Names:

Hypericum Perforatum Extract (U.S.)
Hypericum Perforatum Oil (U.S.)

HYPERICUM PERFORATUM EXTRACTCAS No. EINECS No.
84082-80-4 282-026-4

Definition: Hypericum Perforatum Extract is an extract of the capsules, flowers, leaves and stem heads of the hypericum, *Hypericum perforatum*. See "Regulatory and Ingredient Use Information," regarding the labeling names for botanical derived ingredients in Volume 1, Introduction, Part A.

Information Sources: 21CFR172.510, CIR: [I], HP, JCIC, JCLS, JSQI

Chemical Class: Biological Products

Function: Skin-Conditioning Agent - Miscellaneous

Reported Product Categories: Skin Care Preparations, Misc.; Body and Hand Preparations (Excluding Shaving Preparations); Face and Neck Preparations (Excluding Shaving Preparations); Cleansing Products (Cold Creams, Cleansing Lotions, Liquids and Pads); Shampoos (Non-coloring); Moisturizing Preparations; Night Skin Care Preparations; Bubble Baths; Paste Masks (Mud Packs); Skin Fresheners

Technical/Other Names:

Extract of Hypericum
Extract of Hypericum Perforatum
Hypericum Extract
Hypericum Perforatum (EU)
Saint John's Wort Extract

Trade Names:

Phytelene of St. John's Wort EN 214 powder (Indena SA)
Phytogreen of St. John's Wort EP 494 Powder (Phytochim)
St. John's Wort Spray Dried Extract (Alban Muller)

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